

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric C. Anderson

Examiner: Yogesh K. Aggarwal

Serial No. 09/213,131

Art Unit: 2622

Filed: 12/15/1998

For: **METHOD AND APPARATUS FOR CORRECTING ASPECT RATIO IN A
CAMERA GRAPHICAL USER INTERFACE**

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith. If any fees are required in association with this reply brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF

A. Introduction

Claims 7-9, 11-18, and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Hayakawa. Independent claims 7 and 22 recite that the image capture unit is a digital camera. In the Appeal Brief, Appellant argued that neither reference teaches a digital camera, and that the prior art does not teach or suggest the steps of “rotating the image, if required, so that the image appears upright on a display of the image capture device” and “providing the cropped image to the display” of the digital camera, as recited in the independent claims. In addition, Appellant argued that the Patent Office has not provided any evidence to prove the motivation to modify and/or combine the references, and that the Patent Office is ignoring that the proposed modification would render the reference unsuitable for its intended purpose. The Examiner’s Answer provides no evidence to show that the cited references teach or suggest that the image capture device is a digital camera, or that the image appears upright on a display of the digital camera.

B. Argument

Independent claims 7 and 22 recite that the image capture unit is a digital camera. Neither reference teaches a digital camera. In response, the Patent Office in the Examiner’s Answer states that Parulski teaches that photographic images, such as a set of images of a film strip, are scanned by a high resolution opto-electronic film scanner and output as digitally encoded data (Examiner’s Answer mailed July 31, 2006, p. 5). The Patent Office’s argument seems to boil down to the assertion that the scanner comprises at least an image sensing array (e.g. CCD) and an A/D circuit, which are alleged by the Patent Office to be the essential components of a digital camera. *Ibid.* In addition, the Patent Office alleges that “a scanner as well as a digital camera will perform the same functions of scanning a picture (e.g. a film strip as in Parulski) and digitize the analog image with an analog to digital converter” (Examiner’s Answer mailed July 31, 2006, p. 6). All of the arguments proffered by the Patent Office ignore the simple fact that the scanner of Parulski is not a digital camera. Words in a claim must be given their plain meaning. MPEP § 2111.01.

No one of ordinary skill in the art would consider a scanner to be a digital camera. The scanner of Parulski is a typical scanner and therefore is not equivalent to the claimed digital camera because it fails to teach or suggest “rotating the image, if required, so that the image appears upright on a display of the image capture device” and “providing the cropped image to the display” as recited in claim 7 (see Appeal Brief, pp. 9-10). With the scanner of Parulski, there is no rotating performed so that the image appears upright on a display of the image capture device. Only on the playback device is the image displayed upright (Parulski, col. 3, lines 12-19). Thus, the image never appears upright on a display of the image capture device (the digital camera), and the cropped image is never provided to the display of the image capture device (the digital camera), as required by the claimed invention.

The Patent Office seems to be impermissibly trying to ignore the words “wherein the image capture device is a digital camera.” *In re Wilson*, 424 F.2d at 1385 (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”). The fact that the scanner may contain some of the same elements as a digital camera does not make it a digital camera (*see also* discussion on pp. 7-8 in Appeal Brief filed May 8, 2006). To summarize, the Patent Office’s argument is based on faulty logic. Just because a device X has elements A, B, C, and D and a device Y has common elements A and B, it does not follow that X is Y. Likewise, just because the digital camera of the present invention contains an image sensor 224 and an A/D converter 230 (but many other elements not found in a scanner, including a lens having an iris, a filter 222, a timing generator 226, an analog signal processor (ASP) 228, an interface 232, and one or more motors 234) and the scanner of Parulski contains an image sensor and an A/D converter, it does not follow that a scanner is a digital camera. Likewise, the fact that a scanner may perform some similar functions as a digital camera does not make it a digital camera.¹ The fact is that Parulski does not mention a digital camera at all. For a *prima facie* case of obviousness, the combination must teach or fairly suggest all the claim elements. MPEP § 2143.03. It is clear that neither Parulski nor Hayakawa teach or suggest a digital camera. Therefore, Parulski and Hayakawa do not teach or suggest every limitation of claims 7 and 15. As a result, claims 7 and 15 are allowable.

Since it is clear that Parulski does not disclose a digital camera, Appellant assumed in its Appeal Brief that the Patent Office was attempting to modify Parulski to reach the claimed

¹ See *infra*, p.4 of this Reply Brief.

invention. As set forth in the Appeal Brief, any attempt to modify is improper for the reasons discussed in the Appeal Brief (see Appeal Brief filed May 17, 2006, pp. 6-9).² However, in the Examiner's Answer, the Patent Office admits that it "is not trying to modify the scanner of Parulski into a digital camera to establish a prima facie case of obviousness, rather only trying to establish the fact that the functionality of scanner and a digital camera is same" (Examiner's Answer mailed July 31, p. 6).³ First of all, this is tantamount to an admission that the scanner of Parulski is not the claimed digital camera. The Patent Office attempts to argue that the functionality is the same. However, as discussed above, the mere fact that a scanner may perform some similar functions as a digital camera does not make it a digital camera. Even if a prior art device can perform all of the functions recited in the claim, the prior art does not render the claim unpatentable if there is any structural difference. MPEP §2114; *see In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In the present case, the scanner of Parulski does not even perform all of the functions of the claimed invention (*see* discussion below on failure of Parulski to teach "rotating the image, if required, so that the image appears upright on a display of the image capture device" and "providing the cropped image to the display" as recited in claim 7). However, even if Parulski did perform all the functions of the claimed invention, a point Appellant does not concede, the scanner of Parulski is not a digital camera and therefore, there is a structural difference between the claimed invention and Parulski. MPEP §2114; *see In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). As such, Parulski does not teach or suggest that the image capture unit is a digital camera, as required by the claims.

On page 7, paragraph 3 of the Examiner's Answer mailed July 31, 2006, the Patent Office attempts to respond to Appellant's position that just because there are some common elements between a scanner and a digital camera does not make them the same device. The Patent Office states that "[a] scanner and a digital camera are analogous devices because the

² Appellant also notes that the Patent Office did not address in the Examiner's Answer Appellant's contention that any attempt to modify Parulski to reach the claimed invention would be improper because any such modification renders Parulski unsuitable for its intended purpose of copying analog film into a digital file (*see* Appeal Brief, pp. 8-9). Appellant maintains this argument to the extent that any modification of Parulski is necessary to reach the claimed invention that includes a digital camera.

³ The Patent Office, on page 6, in paragraph 2 of the Response to Argument section of the Examiner's Answer mailed July 31, 2006, also asserts that Parulski is trying to solve a problem that is reasonably pertinent to the problem with which Appellant is involved, and that would have commended themselves to anyone addressing such a problem. This appears to be the test for what constitutes analogous art. *See* MPEP §2141.01(a). However, since Appellant has not asserted that Parulski is non-analogous art in the Appeal Brief, that test is irrelevant. In addition, it does not change the fact that Parulski does not teach a digital camera.

functionality of both devices is same” (Examiner’s Answer mailed July 31, 2006, p. 7). By stating that a scanner and a digital camera are analogous devices, the Patent Office is admitting that the scanner of Parulski is not the claimed digital camera. For a *prima facie* case of obviousness, the test is whether the prior art teaches or fairly suggests all the claim elements. MPEP § 2143.03. The test is **not** whether the prior art teaches or fairly suggests an analogous element to all of the claim elements. Merely being analogous to the claimed element or having some common functionality as the claimed element does not mean the claimed element is taught.

With respect to paragraph 4 on page 7 of the Examiner’s Answer mailed July 31, 2006, Appellant maintains its argument that Parulski fails to teach the claimed steps of “rotating the image, if required, so that the image appears upright on a display of the image capture device” and “providing the cropped image to the display” as recited in claim 7 (see Appeal Brief, pp. 9-10).⁴ Even assuming the scanning device of Parulski is the image capture device, a point which Appellant does not concede, there is no rotating performed so that the image appears upright on a display of the image capture device. Only on the playback device is the image displayed upright (Parulski, col. 3, lines 12-19). Thus, the image never appears upright **on a display of the image capture device**, and the cropped image is never provided to the display of the **image capture device**, as required by the claimed invention. The Patent Office points to Hayakawa as teaching a scanner (Figures 1 and 3) that includes a LCD display 2 for displaying scanned images and an image sensor 51 integrated into one device. (Examiner’s Answer mailed July 31, 2006, p. 8). However, even if combined, as set forth above, Parulski and Hayakawa do not teach or suggest wherein the image capture device is a digital camera, as required by the claims. Thus, the combination of Parulski and Hayakawa does not teach or suggest rotating the image, if required, so that the image appears upright on a display of the image capture device, **wherein the image capture device is a digital camera**. Therefore, the combination of Parulski and Hayakawa does not teach or suggest every limitation of the claimed invention and therefore the combination does not render the claimed invention obvious.

C. Conclusion

Parulski, alone or in combination with Hayakawa, does not teach or suggest that the image capture device is a digital camera. Nor does Parulski and Hayakawa teach or suggest the

⁴ Claim 15 has a corresponding means plus function element.

steps of “rotating the image, if required, so that the image appears upright on a display of the image capture device” and “providing the cropped image to the display” of the digital camera, as recited in the independent claims. Appellant therefore submits that claims 7-9, 11-18, and 20-22 are allowable and requests the Board to instruct the Examiner to allow all pending claims.

Respectfully submitted,

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Date: October 2, 2006
Attorney Docket: 1104-069